

### **REMARKS**

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested.

#### **Status of the Claims**

Claims 1 and 2 were rejected.

Claims 3-11 were previously canceled without prejudice or disclaimer of the subject matter recited therein, with claims 7-11 having been canceled for being drawn to provisionally non-elected subject matter.

Claim 12 has been added.

No new matter has been added.

Claims 1, 2, and 12 are now pending.

#### **Examiner Interview**

Applicants' attorney, Louis J. DelJuidice, conducted telephone interviews with Examiner Mai on April 22, 2009 and April 23, 2009. Applicants' attorney thanks Examiner Mai for the courtesies extended by the Examiner during these interviews. During the interviews, amendments introduced in the February 25, 2009 Amendment and proposed further claim amendments were discussed. Although no agreement was reached, the Examiner indicated that he was open to considering any amendments and arguments in response to a subsequent Office Action, which is the present Office Action mailed on May 14, 2009.

#### **Rejections under 35 U.S.C. §103**

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,506,071 to Tanaka et al. ("Tanaka") in view of U.S. Patent No. 3,345,218 to Brookover et al. ("Brookover"). The rejection is respectfully traversed.

Independent claim 1 recites a surge protector including "oxide films having a Cr (chromium) concentration that is higher at an exterior surface than at an interior surface adjacent to

the respective electrode member.” It is respectfully submitted that Tanaka and Brookover, alone or in combination, do not teach or suggest at least this feature of the presently claimed invention.

Tanaka describes a surge absorber produced by a glass tube sealed by sealing electrodes and having a surge absorbing element and an inert gas. *See* Tanaka, Abstract. The Examiner concedes that Tanaka does not disclose an oxide film having a chromium concentration that is higher at an external surface than at an interior surface adjacent to the respective electrode member, and attempts to cure this deficiency with Brookover. Applicants respectfully disagree.

Brookover is directed to stainless steel alloys having surfaces adapted to glass-to-metal sealing and a method of preoxidation. *See* Brookover, col. 1, lines 8-15. Contrary to the Examiner’s assertions, Brookover does not teach or suggest an oxide film having a higher chromium concentration at one surface than at another surface as recited in claim 1 of the present application. Rather, Brookover describes a preoxidation method that produces “a uniform adherent chromium-enriched oxide film” (emphasis added). *See* Brookover, col. 2, lines 50-55. Brookover’s disclosure of a “uniform” oxide film layer teaches away from the oxide film of the presently claimed invention which has a varied chromium concentration.

Thus, for at least the reasons described above, a combination of Tanaka and Brookover, to the extent proper, does not render independent claim 1 obvious. Withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) based on Tanaka and Brookover is respectfully requested.

Claim 2 was rejected under 35 U.S.C. §103(a) as unpatentable over Tanaka in view of Brookover and U.S. Patent No. 4,410,831 to Shigemori (“Shigemori”).

Independent claim 2 recites features similar to those discussed above with respect to claim 1, and Shigemori does not cure the deficiencies of Tanaka and Brookover. Thus, for at least the reasons described above, a combination of Tanaka, Brookover, and Shigemori, to the extent proper, does not render independent claim 2 obvious.

Withdrawal of the rejection of claim 2 under 35 U.S.C. §103(a) based on Tanaka, Brookover, and Shigemori is respectfully requested.

**New Claim**

New claim 12 has been added. New claim 12 depends from independent claim 1 and recites that the “Cr concentration of oxide films is at least 10% at the exterior surface.” Support for this amendment may be found, for example, on p. 16, lines 22-24 of the originally filed Specification. No new matter has been added. It is respectfully submitted that claim 12 is allowable at least for the reasons discussed above.

**CONCLUSION**

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance and earnestly solicit same. If the Examiner believes there are any remaining issues which can be resolved by a Supplemental Amendment or an Examiner's Amendment, the Examiner is respectfully requested to telephone the undersigned at the telephone number indicated below.

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Respectfully submitted,

By 

Louis J. DelJuidice

Registration No.: 47,522

DARBY & DARBY P.C.

P.O. Box 770

Church Street Station

New York, New York 10008-0770

(212)527-7700

(212)527-7701 (Fax)

Attorney For Applicants